

REMARKS

Claims 1, 3, 4, 11-13, and 15-18 are all of the claims presently pending in the application. Applicants have canceled claims 2, 10, and 14 without prejudice or disclaimer. Applicants have amended claims 1 and 13 to define the claimed invention more particularly.

Applicants believe that entry of these amendments is proper since they do not raise new issues that would require further consideration and/or search. Indeed, Applicants have merely incorporated the subject matter of previously considered dependent claim 14 into independent claim 1. Furthermore, the claim amendments materially reduce the issues on appeal.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-4 and 10-18 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1-4 and 10-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-4, 10-16, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiller et al. (Surface and Interface Analysis, 2000; hereinafter “Stiller”) in view of Seves, et al. (J.Appl. Polym. Sci., 1991; hereinafter “Seves”). Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiller in view of Seves, and further in view of Nakagawa (U.S. Patent No. 5,353,632).

Applicants respectfully traverse these rejections in the following discussion.

I. THE 35 USC §112, FIRST PARAGRAPH REJECTION

The Examiner alleges that claimed invention of claims 1-4 and 10-18 was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and use the invention. The Examiner, however, is clearly incorrect.

Applicants maintain the traversal arguments included in the Amendment filed on December 7, 2006 and the Amendment filed on March 19, 2007, the substance of which is incorporated herein by reference.

Furthermore, Applicants submit that the Notice of Panel Decision from Pre-Appeal Brief Review clearly indicates that this rejection “is withdrawn”. The Examiner alleges, “the Notice of Panel Decision from Pre-Appeal Brief Review indicates that the rejection is withdrawn for *re-opening* the prosecution, not that the rejection is withdrawn *per se*.” (See Office Action dated December 18, 2007 at page 8).

Applicants submit, however, that there is nothing on the record to support the Examiner’s statement above. That is, the Notice of Panel Decision merely indicates that the rejection is withdrawn. Additionally, the Notice of Panel Decision includes an option that states, “A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal.” The Panel, however, did not select this option. Accordingly, from the record, it appears that the Panel determined that there were no actual issues for appeal and the Panel withdrawn the Examiner’s rejection.

If the Examiner contends that it was actually the Panel’s decision to maintain this rejection, Applicants request the Examiner to obtain an updated decision from the Panel, which reflects the Examiner’s allegations.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this

rejection.

II. THE 35 USC §112, SECOND PARAGRAPH REJECTION

The Examiner alleges that the claimed invention of claims 1-4 and 10-18 is indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the claimed invention.

While Applicants maintain that one of ordinary skill in the art would clearly understand the claimed invention, merely in an effort to speed prosecution, Applicants have canceled claim 2 and amended claim 1 as recommended by the Examiner.

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

III. PRIOR ART REJECTIONS

A. The Alleged Combination of Stiller and Seves

The Examiner alleges that one of ordinary skill in the art would have combined Seves with Stiller to teach the claimed invention of claims 1-4, 10-16, and 18. Applicants respectfully submit, however, that, even if combined, the alleged combination of references does not teach or suggest each feature of the claimed invention.

That is, the alleged combination of Stiller and Seves does not teach or suggest, “*a central fragment of said light-sensitive compound between said two arms, which comprises a moiety, said moiety comprising a functional group selected from a group consisting of a sulfide, a thiol, and an isonitrile*”, as recited in exemplary claim 1.

In rejecting dependent claim 14, the Examiner alleged, with respect to Stiller, “The molecule is covalently bonded to the probe through SH-group.” (See Office Action dated

December 18, 2007 at page 7).

The SH-group in Stiller, however, is not a functional group of the moiety at a central fragment of the light-sensitive compound. Indeed, as is clearly illustrated in Figure 1 of Stiller, the SH-group is disposed at an end of one of the arms of the compound. Accordingly, Stiller does not teach or suggest at least this feature of the claimed invention.

Furthermore, Seves fails to make up the deficiencies of the claimed invention. Indeed, the Examiner merely relies on Seves as teaching a compound having two arms and, each having an azo double bond.

Moreover, Applicants submit that one of ordinary skill in the art would not have modified Stiller as alleged by the Examiner. Indeed, Stiller and Seves each disclose completely different chemical compounds. The Examiner is attempting to replace the chemical compound disclosed in Stiller with a completely different compound disclosed in Seves. The Examiner's alleged modification is clearly inappropriate and neither Stiller nor Seves sets forth an reason why one of ordinary skill in the art would replace the compound of Stiller with that of Seves.

Therefore, Applicants submit that the alleged combination of references does not teach or suggest each feature of the claimed invention. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw these rejections.

B. The Nakagawa Reference

The Examiner alleges that one of ordinary skill in the art would have combined Nakagawa with Stiller and Seves to teach the claimed invention of claim 17. Applicants respectfully submit, however, that, even if combined, the alleged combination of references does not teach or suggest each feature of the claimed invention.

Indeed, Applicants submit that claim 17 is allowable at least based on similar reasons to those set forth above in section A with respect to claims 1-4, 10-16, and 18.

Therefore, Applicants submit that the alleged combination of references does not teach or suggest each feature of the claimed invention. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw these rejections.

V. FORMAL MATTERS AND CONCLUSION

With respect to the Examiner's objection, Applicants have canceled claim 10, thus rendering the Examiner's objection moot.

In response to Examiner's objections to the specification, Applicants request the Examiner to refer to the arguments provide above in Section I.

In view of the foregoing, Applicants submit that claims 1, 3, 4, 11-13, and 15-18, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicants respectfully request the Examiner to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, Applicants requests the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/642,615 10
Docket No. YOR920030023US1

The undersigned authorizes the Commissioner to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

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